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Date: <u>July 10, 2003</u>	User No.: <u>CS11618</u>	Flr: <u>29</u> Matter No.: <u>10301614</u>
Return Transmitted Fax To: <u>Conrad Solum</u>		
Re: <u>Kim Patent Appl'n ; S.N. 09/531,356 ; Docket 7297-101C</u>		
REMARKS: <u>To Examiner Appiah: Please excuse the handwriting.</u> <u>In accordance with our teleconference this morning, attached is a copy of pages 14 and 15 of Applicant's Amendment and Response mailed 4/24/03 on which I listed the elements of the Kilinis'159 and Erkkila patents that were set forth in the Office Action and are disclosed in Applicant's parent patent 6,278,884. My notes show where each element is in the '884 patent.</u> <u>If you experience problems with this transmission or have questions, please call 213-892-9373. CP Solum</u>		
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claim was filed February 3, 1998, subsequent to the filing date of April 25, 1997 of Applicant's parent application that resulted in U.S. Patent 6,278,884 (copy of which is enclosed for the Examiner's convenient reference, although obviously it is not prior art), Kikinis '596 is not prior art under 35 U.S.C. Section 102 with respect to anything disclosed in Applicant's Patent No. 6,278,884 that now is incorporated in the subject application by reference.

The Office Action, pages 3 and 4, recites numerous elements and features of Kikinis '596 in support of the claim rejections that are disclosed in Applicant's parent Patent No. 6,278,884 and not in Kikinis '159, whereby those elements and features are not prior art, as follows:

Copied from Office Action recitation re Kikinis '159

- (a) "Mobile entertainment and communication device", *Title; Abstract; radio 60; Fig.*
- (b) "a housing (100) of a palm-held size", *10; Col. 2, line 44; all Figs.*
- (c) "a cell-phone provided in the housing", *8; " " "*
- (d) "a memory provided in the housing", *44 and 46; Col. 3, lines 22, 23; Figs 2 & 4*
- (e) "a microprocessor provided in the housing", *40 and unnumbered "CONTROL" in Figs 2 & 4 Col. 3, line 18*
- (f) "the microprocessor having means for selectively downloading data into memory", *the unnumbered "CONTROL" in Figs 2:*
- (g) "modem", *48; Col. 3, line 30; Figs 2 & 4* *that is connected to 44 and 46*
- (h) "a battery mounted in the housing", and *54; Col. 3, line 67; Figs. 2 & 4*
- (i) "random access memory". *44 and 46; Col. 3, lines 22, 23 and 52-64*

Thus, a substantial proportion of the elements and features of Kikinis '596 relied upon for the claim rejections in the Office Action are not prior art because of Applicant's parent application (now U.S. Patent 6,278,884) that discloses those elements. Thus, all of

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the claim rejections in the Office Action are unsupported for at least this reason and therefore must be withdrawn.

Further, the Office Action relies on Erkkila as a secondary reference in each of the claim rejections under 35 U.S.C. 103(a) but Erkkila was filed in the United States on October 1, 1997, which is subsequent to the April 25, 1997 filing date of Applicant's parent application that resulted in Applicant's U.S. Patent 6,278,884. Again, as with Kikinis '596, Erkkila is not prior art as to anything disclosed in Applicant's parent application that resulted in Patent No. 6,278,884. Specifically, the Office Action recites the following elements and features of Erkkila that are disclosed in Applicant's 6,278,884 patent and therefore not prior art:

- Copied from Office Action recitation re Erkkila*
- (a) "a modular mobile communication system", *Title; Abstract; cell phone 8; all Fig.*
 - (b) "device to provide ... visual communication", *Camera 50, image capture 46 and Modem 48*
 - (c) "store pictures", and *image capture 46*
 - (d) "providing optional functionalities such [as] downloading images and sounds into the communication device". *Control 40, unnumbered "CONTROL" and "captures" 44 & 46*

Thus, Erkkila is not prior art against the subject application for several of the elements and features disclosed and claimed in this application and which are essential to applying Erkkila as a secondary reference under 35 U.S.C. 103(a). This is a separate and additional reason why the claim rejections set forth in the Office Action must be withdrawn.

It should be noted that although it has not been applied in a claim rejection, the cited Farris, et al. (6,167,253) patent was filed December 24, 1997 as a Continuation-in-Part and therefore has the same defects in qualifying as a prior art reference as the Kikinis '596